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Notice of Allowability	Application No.	Applicant(s)	
	10/738,356	JACKSON, RICHARD CHARLES	
	Examiner	Art Unit	
	Jeff H. Aftergut	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to preliminary amendment filed 4-6-04.
2. ☒ The allowed claim(s) is/are 9,10 and 18.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| <ol style="list-style-type: none"> 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>1-12-04</u> 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | <ol style="list-style-type: none"> 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>----</u> 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance 9. <input type="checkbox"/> Other _____ |
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Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 7, 8, 16, and 17, drawn to a process of making a decorative device, classified in class 264, subclass 349.
- II. Claims 9, 10, and 18, drawn to a method of transforming a decorative scene using the decorative device, classified in class 156, subclass 63.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making a product and process of using the product. The use as claimed can be practiced with a product made via a materially different process such as one which formed the forms from a rubber other than silicone rubber and subjected the same to a painting operation. Additionally the method of making the articles for the snowfield could be used in a materially different process such as one for displaying a toy train assembly and wherein there is no cutting involved for the resilient forms of the display. Restriction is proper between said method of making and method of using as the patentability of one does not hinge on the patentability of the other.

3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with John Klos on 8-23-06 a provisional election was made with traverse to prosecute the invention of Group II, claims 9, 10, and 18.

EXAMINER'S AMENDMENT

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with John Klos on 9-24-06.

The application has been amended as follows:

In the claims:

Claims 7, 8, 16, and 17 have been cancelled as being directed to a non-elected invention. The election having been made with traverse (see above).

In claim 9, line 5, the word "amatte" has been changed to - -a matte- -.

7. The following is an examiner's statement of reasons for allowance: None of the prior art of record taught or suggested the transforming of a decorative scene where a plurality of white generally flat resilient forms having a generally tacky surface and a matte surface generally opposite the tacky surface, placing some of the forms on the model wherein the tacky surface maintains the forms in place, cutting others of the resilient forms to correspond to edges of the model and placing these cut forms on relation to the edge so as to transform the model from a season inspecific model to a

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winter theme scene. The reference to Sisler suggested the placement of pieces on a house form (see Fig 6) however the pieces were not expressly recited to have been cut to coincide with the edges of the house and are not recited as being resilient forms having a tacky surface on one side and a matte surface on the other. The reference to Donofrio suggested the assembly of a piece of foamed plastic on a roof of a house however the reference did not teach the cutting of the piece to correspond to the edge of the model. The reference to Yamamoto taught the deposition of artificial snow on a house display but did not perform the operation in a manner similar to that claimed. The reference to Ojeda taught the placement of pieces of decoration on a house however the pieces disposed there on are not cut to correspond to an edge of the house and are not resilient in nature having a tacky side and a matte side thereon.

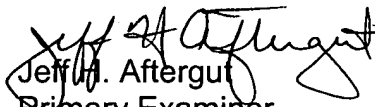
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jeff M. Aftergut
Primary Examiner
Art Unit 1733

JHA
August 28, 2006